IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

19/ Reply Brief, gd 7-15-91

BEFORE THE BOARD OF APPEALS

Re Application: TRACK LIGHTING SYSTEM FOR 277 VOLT POWER LINE
Inventor: Ole K. Nilssen
Serial Number: 07/511,951
Filing Date: 04/16/90

Art Unit: 252
Examiner: ZARABIAN, A.

Applicant's Phone Number: 708-658-5615

REPLY BRIEF

91-2861

Commissioner of Patents and Trademarks
Washington, D.C. 20231

In response to Examiner's Answer to Applicant's Appeal Brief, Applicant provides a Reply Brief in the form of the following comments.

Re Mr. Fiene's Affidavit

Examiner dismisses Mr. Fiene's affidavit as merely representing a personal opinion and therefore unpersuasive.

Applicant disagrees with Examiner's position.

Mr. Fiene -- who is an expert in the particular field to which the claimed invention pertains -- has read the various claims at issue as well as all the applied references.

In his Affidavit, Mr. Fiene testifies with respect to his interpretation of the material presented in the applied references. And, according to Mr. Fiene's testimony -- which includes explanations, as appropriate -- it would be highly unusual to combine the teachings of the various applied references in such ways as to attain the claimed invention.

In particular and by way of example, Mr. Fiene testifies to the effect that "in his opinion" it "would be highly unusual -- to say the least" to use Kivari's lamp in Neumann's track lighting system or in connection with Spira's gas discharge lighting system; whereafter Mr. Fiene proceeds to identify the facts and circumstances underlying his "opinion".

Clearly, rendering a meaningful opinion with respect to whether or not such propositions could reasonably be defined as "unusual" or not, can only be done by a person possessing at least a modicum of knowledge with respect to the pertinent art. In view of the record, it is abundantly clear that -- with respect to the pertinent art -- Mr. Fiene does indeed possess at least such a modicum of knowledge. As for Examiner, there is nothing in the record to indicate that he possesses even a modicum of knowledge with respect to the pertinent art. Hence, on basis of the record, Mr. Fiene's opinion is more authoritative that that of Examiner for the reason that his opinion is at least based on a modicum of knowledge with respect to the pertinent art, whereas Examiner's opinion is unsupported by any form of verification of knowledge with respect to the pertinent art.

Thus, Mr. Fiene's opinion with respect to what would be "unusual" to do versus what would not be "unusual" to do (within the context of the art pertinent hereto) must be given far more weight than Examiner's opinion in that regard.

Examiner argues that "All US patents are presumed valid, unless proved otherwise".

Applicant does not disagree with that proposition.

However, it is important to recognize that the key word is presumed. Obviously any presumption must be corrected in light of evidence to the effect of showing this presumption to be erroneous.

And that is exactly what Mr. Fiene has done with respect to at least part of Kivari's disclosure; which is to say: with respect to Kivari's patent, Mr. Fiene's expert testimony represents evidence to the effect that Kivari's lamp is non-functional and therefore invalid as a referene.

In the next-to-last paragraph of his Answer, Examiner states that:

"With respect to the opinions of obviousness, the affiant ... is not qualified as a registered attorney so his opinion with respect to legal issues such as obviousness ... is given no weight".

This statement by Examiner illustrates what Applicant has found to be a basic problem with PTO examiners in general: these examiners seem to forget the basic fact that an examiner's finding of obviousness represents nothing more than this examiner's subjective prima facie opinion with respect to what he believes would be obvious to a person having ordinary skill in the pertinent art. Yet, that subjective prima facie opinion is reached by this examiner without the benefit of possessing even an ordinary level of skill in the pertinent art.

Then, when presented with expert testimony (i.e., an expert's carefully justified opinion) showing that the examiner's subjective prima facie opinion was incorrect, the examiner rejects such testimony with the "argument" that it merely represents some other person's opinion and therefore need not be taken into account.

In instant case, Mr. Fiene is such an expert; and -- in the area of his particular expertise -- his carefully justified opinion must clearly be given more weight than Examiner's opinion, who's opinion -- on basis of the record -- must be considered as a strictly non-expert opinion.

Also, as is well established by prior court decisions, even the inventor (or author) of a reference (e.g., Mr Kivari) may not be considered an expert in the area pertinent to his own invention. This is so for the very plain reason that there is no requirement imposed on an inventor (or author) to the effect of verifying that he is an expert in the art most pertinent to his own invention.

Thus, with respect to the claimed invention and all the applied references, Mr. Fiene is the only person of record who may reasonably be classified as an expert in the pertinent art. Yet, Examiner proceeds to disregard Mr. Fiene's expert opinion in favor of his own non-expert opinion.

Ole K. Nilssen, Pro Se Applicant